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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/549,988	04/14/2000	Jeffrey M. Chasen	109905-134328	8258

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EXAMINER

BOCCIO, VINCENT F

ART UNIT PAPER NUMBER

2616

DATE MAILED: 08/18/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/549,988

**Applicant(s)**

CHASEN, JEFFREY M.

**Examiner**

Vincent F. Boccio

**Art Unit**

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 49,52 and 62-82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49,52 and 62-82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

**Response to Arguments**

1. Applicant's arguments with respect to amended and new claims have been considered but are moot in view of the new ground(s) of rejection.

**Claim Objections**

1. Claim 69 is objected to because of the following informalities:

Claim 69, recites "metadata The computer ...",  
The examiner suggests, remove the capital "T", and  
replace with lower case character, recite as,

"metadata the computer ..."

Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless --  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
3. Claims 49, 62-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinada (US 5,436,875).

Regarding claim 49, Shinada discloses and meets the limitations as recited a method for playing and simultaneously recording an audio stream to an audio disk file, the method comprising:

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- receiving from a optical disk player (Fig. 1), a first audio stream originating from a first audio disk file (disk 2, col. 7, "audio signal S2");
- incrementally storing the first audio data starting at a first point corresponding to a beginning (met by a starting location) of the first audio optical disk file, wherein the first audio is received and stored at a first rate that is higher than a playback rate (col. 7, memory 22 outputs at a rate or playback rate = .3 M bits/sec), prescribed for the first audio optical disk file (col. 6, recording rate = 1.4 M bits/sec); and
- incrementally playing the stored first audio data during the storing of the first audio data stream (Fig. 6 A-D, col. 11, "contents of the recording program can be listened from the beginning although the recorded program has not been completed.").

Regarding claims 62-65, Shinada inputs at .3 M bits/sec, which is the real time recording rate such as received thru an antenna and processed to digital, in Fig. 8 or Fig.1, {audio broadcast program, provided in real time}, wherein the real time audio rate is .3 M bits/sec input audio stream into element 16 in Fig.1, also reference cols. 6-8 etc....., wherein since .3 is real time, 1.4 M bits/sec is higher than real time;

- wherein the first audio is incrementally played at real time during the storing of the first audio data (Fig. 6 A-D, col. 11, lines 60- and output of memory 22 is .3 M bits/sec or the same rate input to memory 18, or the real time audio data rate);
- wherein further comprising encoding the first audio data, wherein the first audio data is received and encoded (by encoder 14), stored (by "disk 2") at a rate that is higher than real time (.3 M bits/sec) and encoded at a rate that is greater than real time (1.4 M bits/sec).

Regarding claim 66 Shinada further comprises:

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- stopping (Fig. 5 A & B, either met by memory 22 full, step SP17 simultaneous R & R, operation or step SP8 reproduction operation only) the storing (to disk) of the first audio data at a second point within the first audio optical disk file (stop point after the starting point, when simultaneous operation is desired by the user);
- receiving from the optical disk player device, a second audio data stream originating from the first audio optical disk file (playback operation triggered by a user is continuous until changed by the user); and
- incrementally playing the second audio data starting at the first point corresponding to the beginning of the first audio optical disk file, while the second audio data is incrementally stored beginning at the second point within the first audio optical disk file (Figs. 5 A & B and Fig. 6 A-D);

Regarding claims 67-68, Shinada further meets the limitations of wherein the first audio is incrementally stored to a local storage device (either met by 27 and/or disk 2), as a first electronic file and the second audio data is also incrementally stored as part of the first electronic data file (met by memory 27 for incoming/data stored in memory 27/18, to be recorded & outgoing/data reproduced to memory 27/22 to be reproduced to an audio appliance.

Regarding claims 69-70, Shinada further meets the limitation of having META data (col. 4, U-TOC, allows reproduction of areas corresponding to user's selection) and wherein the optical disk meets the limitation of a compact disk or CD.

**Claim Rejections - 35 USC § 103**

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 52, 71-79 and 80-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinada (US 5,436,875).

Claims 52, 72-79, 81-83 are analyzed and discussed with respect to the claims above,

further Shinada fails to particularly disclose a CPU, by, merely a controller for performing the steps, therefore, fails to disclose the limitations of a computer readable medium, or a program with instructions for performing the operation of the system.

The examiner takes official notice that providing a control program on a computer readable medium allowing a CPU to control the system or software implementation of the operation even encoding and decoding is well known and obvious to those skilled in the art, therefore, it would have been obvious to those skilled in the art at the time of the invention to implement the system with a computer readable medium, wherein software has an advantage of upgrading only involves a new program, not as simple with a hardware implementation, wherein each does have their own advantages.

Regarding claims 71 and 80, Shinada further meets the limitation of storing with one of a plurality of digital encoding formats (Fig. 1, "encoder 16 and decoder 24", col. 6, "encoder 16 audio compression processing ... according to a prescribed format", representing audio compression and decompression, inherently according to a standard), wherein the system performs identifying by knowing the encoding and therefore knows the proper decoding to use.

Shinada fails to particularly mention identifying within, one of encoding formats of the audio stream of data encoded.

The examiner takes official notice that providing ID information to identify the encoding (compression standard etc.....) method, is well known and obvious, therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the

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Shinada to provide an ID with respect to the compression format or standard used, thereby upon reproduction to select and properly decode the compression audio data, as is well known to those skilled in the art.

#### **Conclusion**

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Contact Fax Information**

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:  
(703) 872-9314, (for formal communication  
intended for entry)

or:  
(703) 308-5359, (for informal or draft  
communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to  
Crystal Park II, 2121 Crystal Drive, Arlington,  
VA., Sixth Floor (Receptionist).


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Contact Information

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
8/10/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER